

REMARKS

Reconsideration of the present application in view of the foregoing amendments and following remarks is requested respectfully.

Claims 1 - 22 are presented. No claims have been amended, added or cancelled.

I. OBJECTIONS TO THE DRAWINGS

Applicants acknowledge the Examiner's comments with respect to the drawings, including the notation that the drawings are acceptable for examination purposes.

Upon the indication of allowable subject matter by the Examiner, applicants will file the appropriate petition for acceptance of the color photographs.

II. THE CLAIMS DEFINE PATENTABLE SUBJECT MATTER

A. Summary Of The Claimed Invention

The presently claimed invention defines articles (claims 1 – 16) containing a unique combination of components in amounts effective to provide a specific and highly desirable appearance to the article. In claim 1, for example, 80 parts by weight to about 99 parts by weight of vegetable-derived compounds are combined with from about 1 to about 20 parts by weight of insect wax to provide one or more of the surface layer appearances described in the claim. By way of additional example, claim 11 requires an article in which the vegetable based compounds comprise stearic acid and esters of stearic acid.

The presently claimed invention also defines methods of fabricating molded articles which comprise a combination of steps, including the provision of compositions comprising vegetable derived components and insect derived components and molding the composition into the desired shape (claims 17 -22). Important to these claims as

now presented is the requirement of a molding operation in which the composition includes insect wax in an amount effective to cause sufficient shrinkage of the molded article to improve the release properties of the composition upon removal from the mold. In claim 20, the method requires that the composition comprises at least 3 weight percent bees wax.

As described in the present specification, it is not fully understood why the present invention produces these unique and highly decorative effects or the advantageous molding characteristics. It is understood, however, that certain combinations of components do not produce the desired effect. For example, on page 5, lines 29 - 30, it is noted that desirable aesthetic effects are generally not achieved for certain embodiments, namely, those in which insect wax is employed at concentrations of less than about 1% or at about 20% or above. Furthermore, applicants disclose that the advantageous aesthetic features of the present invention are generally not achieved with compositions that eliminate the vegetable -- based compounds and utilize instead petroleum-derived compounds.

B. Baumer Does Not Inherently Disclose The Claimed Invention

In the outstanding office action, the Examiner has rejected claims 1, 6, 7, 8, 9, 10, 17, 18, 19, 20 and 22 as anticipated by United States Patent 1,958,462 - Baumer. More specifically, the Examiner has asserted that this patent discloses, "a molded candle formed from a mixture of about 80 parts hydrogenated vegetable derived compound (sic) 20% insect wax (beeswax)." Based upon this statement, the Examiner concludes, "the composition of Baumer would inherently provide a surface layer with an appearance [as specified in the claims]." Applicants respectively traverse the Examiner's contentions in this regard.

An item of prior art can only inherently anticipate a claim if the disclosure of that item invariably and always produces the claimed invention. This standard is not met in the present case. In fact, the Baumer patent not only fails to inherently disclose the

present invention, it clearly teaches away from certain embodiments. For example, claim 8 requires "less than about 20 parts by weight of insect wax," and the specification explains that in certain embodiments the presence of 20% or greater of insect wax results in the absence of the aesthetic effects which are the object of those embodiments of the present invention. (Specification, page 5, lines 29 - 30). In contrast, Baumer teaches away from the present invention as thus claimed by specifically stating that beeswax should be present in amounts of "at least 20 % by weight..." (Col. 1, line 55 – col. 2, line 2). Thus, it is readily apparent that, in the absence of the present teaching, one skilled of the art that followed Baumer would not always and invariably achieve the unique and desirable aesthetic effects described in the present application; in fact one skilled in the art would be lead away from the requirements of the present invention. Furthermore, Baumer does not disclose each of the methods steps of the present invention; it certainly does not inherently disclose the requirement that insect wax is present in amount effective to cause sufficient shrinkage of the molded article to improve the release properties of the composition upon removal from the mold. Thus, it is respectfully submitted at the Examiner's contentions of inherent disclosure are not proper and should be withdrawn.

C. The Claimed Invention is Not Obvious

The Examiner has rejected claims 2 – 5, 11 – 16 and 21 as being unpatentable over Baumer in view of Will. More specifically, after repeating his contentions regarding the inherent disclosure in Baumer, the Examiner states "Baumer does not disclose the vegetable wax to be made from a mixture of stearic acid and ester of stearic acid as set forth in applicants claims." In an effort to overcome this acknowledged deficiency, the Examiner asserts that Will teaches "forming non-paraffin based candles from mixtures of stearic acid and hydrogenated vegetable oil," and that therefore the present invention is obvious over the combination of Baumer and Will. Once again, applicants respectively traverse the Examiner's contentions.

As an initial matter, applicants note that the Examiner's position relies upon the assertion of an inherent disclosure that does not in fact exist. Accordingly, the Examiner's rejection must fail because it is based upon a faulty premise with respect to the alleged "inherent disclosure" in the Baumer patent. In any event, it is also known as a matter of law that it is not proper to rely upon inherent teachings as part of an obviousness rejection. For these reasons alone, applicants respectfully request that the Examiner withdraw the rejection.

Additionally, applicants note that there is no disclosure in the Will patent, or in the Baumer patent for that matter, which would suggest using a combination of stearic acid and esters of stearic acid, much less a combination within the ranges specified in certain of the claims (claims 13, 15 and 16). Will does not disclose a combination of stearic acid and esters of stearic acid, as required in claims 12 - 16.

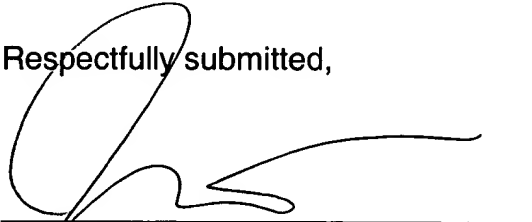
Thus, applicants note that there is no suggestion in the prior art that would provide the motivation necessary to combine the disclosures of the Baumer patent and the Will patent to achieve the unique and desirable aesthetic effects of the present invention or the beneficial molding characteristics. Furthermore, even if these two patents were combined as suggested by the Examiner, a person skilled in the art would have no reasonable expectation of achieving the unexpected and desirable aesthetic and mold release properties presently claimed.

April 9, 2004

III. CONCLUSION

In view of the above amendment and remarks, the applicant requests respectfully that the Examiner reconsider the outstanding rejections of the claims set forth in the Office Action.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'J. Posillico', written over a horizontal line.

Dated: April 9, 2004

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